

Application No. 09/994,492
Amendment dated January 5, 2004
Reply to Office Action of September 3, 2003

REMARKS

Claims 1-6, 8-14, 16-18, 21-23, 25-27, and 30-35 are pending in the application. Claims 7, 15, 19, 20, 24, 28, 29, and 36-42 are hereby canceled without prejudice. The Examiner rejected all pending claims.

Claim Objections

Applicant has cancelled Claim 7 rendering moot the Examiner's 37 CFR 1.75(c) objection to the same.

Claim Rejections – 35 U.S.C. §102

The Examiner rejected Claims 1, 2, 4, 7, 8, 10, 13, 15, 16, 19, 20, 21, 24, and 25 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,716,057 (hereinafter "Rubin '057").

Rubin '057 discloses "[a] chisel for cutting bony tissue." E.g., U.S. Patent No. 3,716,057, abstract. The chisel of Ruben '057 is designed to guard against side-slip or deflection of the cutting end of the instrument during a bone cutting operation. To this end, the corners of the instrument of Rubin '057 at the cutting end are rounded and dulled. Rubin '057 makes no mention of the thickness of the rounded and dulled corners. The instrument of Rubin '057 does not include a curved head.

Independent Claim 1 calls for a ligament cutter comprising, *inter alia*, a handle, a head, and spacer means connected to the head for extending the spacing between a pair of bones forming a joint and thereby tensioning a ligament joining the pair of bones. Rubin '057 does not disclose or suggest a ligament cutter including spacer means for extending a spacing between a pair of bones forming a joint and thereby tensioning a ligament joining the pair of bones, as called for in Independent Claim 1. The bone chisel of Ruben '057 is not designed to extend the spacing between a pair of bones forming a joint to tension a ligament joining the pair of bones and does not disclose or suggest a spacer means capable of doing so. While the corners of the

Application No. 09/994,492
Amendment dated January 5, 2004
Reply to Office Action of September 3, 2003

instrument of Rubin '057 are rounded and dulled, Rubin '057 does not disclose or suggest that the corners are capable of functioning to extend the spacing between a pair of bones forming a joint and thereby tension a ligament joining the pair of bones, as called for in Independent Claim 1. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §102(b) rejection of independent Claim 1 as was Claims 2 and 4 depending therefrom.

Independent Claim 8 calls for a ligament cutter comprising, *inter alia*, a handle, a head, and a pair of joint spacers having a thickness whereby the joint spacers are operable to extend a joint space between a femoral head and an acetabulum to thereby tension a ligamentum teres femoris. As indicated above with respect to independent Claim 1, Ruben '057 does not disclose or suggest a joint spacer having a thickness such that the joint spacer is operable to extend the joint space between a femoral head and an acetabulum to thereby tension a ligamentum teres femoris, as called for in independent Claim 8. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §102(b) rejection of Claim 8 and Claims 10 and 13 depending therefrom.

Claims 16, 21, and 25 have all been rewritten in independent form. Claims 16, 21, and 25, as amended, all call for a ligament cutter comprising, *inter alia*, a handle, and a head having a radius of curvature whereby the head can be positioned intermediate a ball and a socket of a ball-and-socket joint. Rubin '057 does not disclose or suggest a ligament cutter including a head having a radius of curvature as called for in independent Claims 16, 21, and 25. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §102(b) rejection of Claims 16, 21, and 25.

Applicant has canceled Claims 7, 15, 19, 20, and 24 without prejudice, rendering moot the Examiner's 35 U.S.C. §102(b) rejection thereof.

The Examiner rejected Claims 28, 29, 30, 36, and 37 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,135,528 (hereinafter "Winston '528").

Winston '528 discloses a hockey stick chisel for performing a vertebral osteotomy. the chisel of Winston '528 includes elongated handle member 5 connected to curved blade member 6

Application No. 09/994,492
Amendment dated January 5, 2004
Reply to Office Action of September 3, 2003

as illustrated in Fig. 1. Curved blade member 6 has a radius of curvature 10 in a plane containing bone cutting edge 20.

Claim 30 has been rewritten in independent form. Claim 30, as amended, calls for a ligament cutter comprising, *inter alia*, a handle, a head having a distal end with a blade, the head having a curvature in a plane perpendicular to the blade, the curvature of the head substantially matching the curvature of a femoral head. Winston '528 does not disclose or suggest a ligament cutter including a head having a blade, with the head having a curvature in a plane *perpendicular* to the blade as called for in Independent Claim 30. To the contrary, the curvature of the head of Winston '528 is in a plane *containing* the blade. Further, Winston '528 does not disclose or suggest that the curvature of the head substantially match the curvature of a femoral head as called for in independent Claim 30, as amended. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §102(b) rejection of Claim 30.

Applicant has canceled Claims 28, 29, 36, and 37 without prejudice, rendering moot the Examiner's 35 U.S.C. §102 rejection thereof.

Claim Rejections – 35 U.S.C. §103

The Examiner rejected Claims 3, 5, 6, 9, 11, 12, 14, 17-18, 22, 23, 27, 28, 31-35, and 38-42 under 35 U.S.C. §103 as being unpatentable over Rubin '057 in view of Winston '528.

Claims 3, 5, and 6 depend from Independent Claim 1. As indicated above, Rubin '057 does not disclose or suggest a ligament cutter including spacer means for extending a spacing between a pair of bones forming a joint and thereby tensioning a ligament joining the pair of bones, as called for in Independent Claim 1. Winston '528 similarly does not disclose or suggest a ligament cutter including spacer means for extending a spacing between a pair of bones forming a joint and thereby tensioning a ligament joining the pair of bones, as called for in Independent Claim 1. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §103 rejection of Claims 3, 5, and 6 which all depend from Claim 1.

Application No. 09/994,492
Amendment dated January 5, 2004
Reply to Office Action of September 3, 2003

Claims 9, 11, and 12 depend from Independent 8. As indicated above, Ruben '057 does not disclose or suggest a joint spacer having a thickness such that the joint spacer is operable to extend the joint space between a femoral head and an acetabulum to thereby tension a ligamentum teres femoris, as called for in independent Claim 8. Winston '528 similarly does not disclose or suggest a joint spacer having a thickness such that the joint spacer is operable to extend the joint space between a femoral head and an acetabulum to thereby tension a ligamentum teres femoris, as called for in independent Claim 8. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §103 rejection of Claims 9, 11, and 12 which all depend from Claim 8.

Independent Claim 14 calls for a ligament cutter comprising, *inter alia*, a head having a radius of curvature whereby the head can be positioned intermediate a ball and a socket of a ball-and-socket joint. Neither Rubin '057 nor Winston '528 discloses or suggests a ligament cutter including a head having a radius of curvature as called for in independent Claim 14. While Winston discloses an instrument having a head with a radius of curvature, Winston does not disclose or suggest that head is shaped to be positioned intermediate a ball and a socket of a ball-and-socket joint. The chisel of Winston '528 is designed to allow for a vertebral osteotomy when the vertebral bone which is sought to be cut is located anterior to the patient's spinal cord. Winston '528 does not disclose or suggest an instrument having a head shaped to be positioned intermediate a ball and a socket of a ball-and-socket joint as called for in Independent Claim 14. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §103 rejection of Claim 14.

Claims 17, 18, 22, 23, and 27 all depend from one of Independent Claims 16, 21, and 25. Independent Claims 16, 21, and 25, as amended, all call for a ligament cutter comprising, *inter alia*, a handle, and a head having a radius of curvature whereby the head can be positioned intermediate a ball and a socket of a ball-and-socket joint. Rubin '057 does not disclose or suggest a ligament cutter including a head having a radius of curvature as called for in independent Claims 16, 21, and 25. As indicated in the previous paragraph, Winston '528 does

Application No. 09/994,492
Amendment dated January 5, 2004
Reply to Office Action of September 3, 2003

not cure this deficiency. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §103 rejection of Claims 16, 21, and 25.

Claims 31-35 depend from Independent Claim 30. Independent Claim 30, as amended, calls for a ligament cutter comprising, *inter alia*, a handle, a head having a distal end with a blade, the head having a curvature in a plane perpendicular to the blade, the curvature of the head substantially matching the curvature of a femoral head. Winston '528 does not disclose or suggest a ligament cutter including a head having a blade, with the head having a curvature in a plane *perpendicular* to the blade. To the contrary, the curvature of the head of Winston '528 is in a plane *containing* the blade. Further, Winston '528 does not disclose or suggest that the curvature of the head substantially match the curvature of a femoral head as called for in independent Claim 30, as amended. Rubin '057 does not cure this deficiency. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §103 rejection of Claims 31-35.

Applicant has canceled Claims 28, and 38-42 without prejudice, rendering moot the Examiner's 35 U.S.C. §103 rejection thereof.

It is believed that the above represents a complete response to the Official Action and reconsideration is requested. Specifically, Applicant respectfully submits that the current application is in condition for allowance and such action is earnestly solicited.

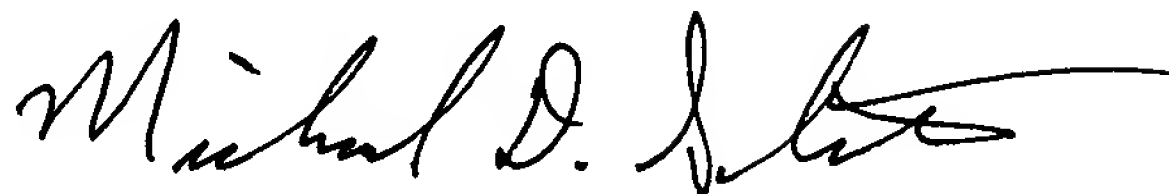
In the event Applicant has overlooked the need for an extension of time or payment of fee, Applicant hereby petitions therefor and authorizes that any charges be made to Deposit Account No. 02-0385, BAKER & DANIELS.

Application No. 09/994,492
Amendment dated January 5, 2004
Reply to Office Action of September 3, 2003

If any questions concerning this application should arise, the Examiner is encouraged to telephone the undersigned at 260/424-8000.

Respectfully submitted,

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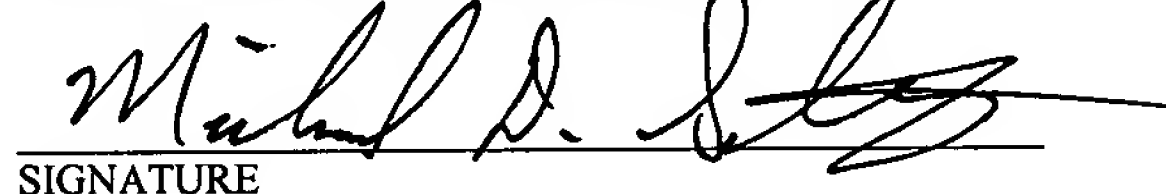
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January 5, 2004

DATE